11-24-03

1639

PTO/SB/21 (08-03)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# TRANSMITTAL FORM

*(to be used for all correspondence after initial filing)*

| | |
|---|---|
| Application Number | 10/057,178 |
| Filing Date | January 24, 2002 |
| First Named Inventor | Kit S. Lam |
| Art Unit | 1639 |
| Examiner Name | Jon D. Epperson |
| Attorney Docket Number | 8141/9886 |

Total Number of Pages in This Submission: 7



## ENCLOSURES *(Check all that apply)*

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Response to Missing Parts/ Incomplete Application
  - [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
- [ ] After Allowance communication to Group
- [ ] Appeal Communication to Board of Appeals and Interferences
- [ ] Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
- [ ] Proprietary Information
- [ ] Status Letter
- [X] Other Enclosure(s) (please Identify below):
  1. Copy of Notice to Comply
  2. Response to Notice to Comply
  3. Return card

Remarks

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|---|---|
| Firm or Individual name | Audrey A. Millemann, Reg. No. 44,942<br>Weintraub Genshlea Chediak Sproul |
| Signature | Audrey A. Millemann |
| Date | November 21, 2003 |

## CERTIFICATE OF TRANSMISSION/MAILING (Express Mail No. EL939552976US)

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as Express Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Mail Stop Art Unit 1639

| | | | |
|---|---|---|---|
| Typed or printed name | Audrey A. Millemann | | |
| Signature | Audrey A. Millemann | Date | Nov. 21, 2003 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



| | |
|---|---|
| Applicants: | Kit S. Lam and Alan L. Lehman |
| Serial No.: | 10/057,178 |
| Filed: | January 24, 2002 |
| For: | Method for Determining Differences in Molecular Interactions and for Screening A Combinatorial Library |

Art Unit: 1639
Examiner: Jon D. Epperson

November 21, 2003
Sacramento, California 95814

Mail Stop Art Unit 1639
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

## RESPONSE TO NOTICE TO COMPLY: SEQUENCE RULES

This paper is in response to the Notice to Comply: Sequence Rules (Bonafide) mailed by the Examiner on October 29, 2003.

The Examiner objected to the application on the grounds that it contains amino acid sequences within the meaning of 37 C.F.R. §1.821(a)(2) and does not comply with the requirements of 37 C.F.R. §§1.821-1.825. The Examiner referred to amino acid sequences disclosed on pages 32 and 33 of the specification, and requested that applicants check the entire specification for compliance.

Applicants respectfully point out that 37 C.F.R. §1.821(a)(2) exempts amino acid sequences containing D-amino acids from the requirements of §§1.821-1.825, including submission of a "Sequence Listing." Subsection (a)(2) of §1.821 states:

> "Those amino acid sequences containing D-amino acids are not intended to be embraced by this definition."

Subsection (b) of §1.821 states:

> "Patent applications which contain disclosures of nucleotide and/or amino acid sequences, in accordance with the definition in paragraph (a) of this section, shall, with regard to the manner in which the nucleotide and/or amino acid sequences are presented and described, conform exclusively to the requirements of §§ 1.821 through 1.825."

Thus, amino acid sequences containing D-amino acids do not fall within the requirements of §§1.821 through 1.825. (See also *Manual of Patent Examining Procedure*, §§ 2421.02, 2422, and 2422.01.)

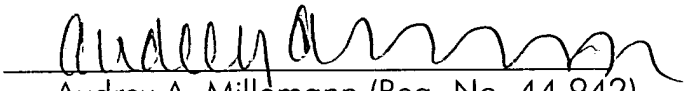
The only amino acid sequences disclosed in applicants' patent application are set forth on pages 32 and 33 of the specification, in the example of the method, which is described on pages 26-33. These were peptide ligands identified using the method of the invention. All of the peptide ligands disclosed contain the D-amino acid D-cysteine, as demonstrated by the fact that the combinatorial library from which the ligands were obtained was a peptide library having the general structure of cXXXXXXc, where "c" is D-cysteine. (Specification, 20:5-6; see also specification,

17:17-19). Because all of the ligands disclosed contain a D-amino acid, §§1.821-1.825 do not apply and no correction to the specification is necessary.

Respectfully submitted,

KIT S. LAM and ALAN L. LEHMAN

Date: November 21, 2003

By: 

Audrey A. Millemann (Reg. No. 44,942)
Attorney for Applicants
Weintraub Genshlea Chediak Sproul
Law Corporation
400 Capitol Mall, Eleventh Floor
Sacramento, California 95814
916/558-6033

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov



| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/057,178 | 01/24/2002 | Kit S. Lam | 8141/9886 | 5311 |

7590 10/29/2003

Audrey A. Millemann
Weintraub Genshlea Chediak Sproul Law Corporation
11th Floor
400 Capitol Mall
Sacramento, CA 95814

| EXAMINER | |
|---|---|
| EPPERSON, JON D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1639 | |

DATE MAILED: 10/29/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.





Express Mail No. EL939552976US

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Applicant Copy

| APPLICATION NO./CONTROL NO. | FILING DATE | FIRST NAMED INVENTOR /PATENT IN REEXAMINATION | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 10/057,178 | 1/24/2002 | Lam et al | 8141/9886 |



| EXAMINER |
|---|
| Jon D. Epperson |

| ART UNIT | PAPER |
|---|---|
| 1639 | 5 |



DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents**

**Notice To Comply: Sequence Rules (Bonafide)**

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the following reason(s): For example, see bottom of 32 and top of page 33 wherein multiple amino acid sequences are disclosed (e.g., HTLHQ). Please also re-check the **entire** specification for compliance. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

**APPLICANT IS GIVEN A ONE MONTH EXTENDABLE PERIOD WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 CFR 1.821 - 1.825.** Failure to comply with these requirements will result in **ABANDONMENT** of the application under 37 CFR 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Please direct all replies to the Unite States Patent and Trademark Office via one (1) of the following:
1. Electronically submitted through EFS-Bio
(<<Http://www.uspto.gov/ebc/efs/downloads/documents.htm>>, EFS Submission User Manual - ePAVE)
2. Mailed to:
U.S. Patent and Trademark Office
Box Sequence, P.O. Box 2327
Arlington, VA 22202

Any inquiry concerning this communication should be directed to Jon D. Epperson whose telephone number is (703) 308-2423. The Examiner can normally be reached on Monday through Friday from 9 am to 6 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (703) 306-3217. The fax number for this group is (703) 305-3014. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0196.

Jon D. Epperson
AU 1639

BENNETT CELSA
PRIMARY EXAMINER

| Notice to Comply | Application N<br>10/057,178 | Applicant(s)<br>Lam et al | |
|---|---|---|---|
| | Examiner<br>Jon D. Epperson | Art Unit<br>1639 | Paper No<br>5 |

## NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).

☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).

☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).

☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."

☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).

☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable from of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).

☒ 7. Other: For example, see bottom of 32 and top of page 33 e.g., HTLHQ. Re-check entire spec.

### Applicant Must Provide:

☒ An **initial** or substitute computer readable form (CRF) copy of the "Sequence Listing".

☒ An **initial** or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry into the specification.

☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216 or (703) 308-2923
For CRF Submission Help, call (703) 308-4212
Patent Software Program Support
Technical Assistance.....703-287-0200
To Purchase Patent Software.....703-306-2600



**PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR REPLY**